

DEC 12 2006

ATTORNEY DOCKET NO. 11470BAUS01U (NORT10-00350)
U.S. SERIAL NO. 09/577,292
PATENT**REMARKS**

Claims 1-12, 14-43, 45-61 and 63-65 are pending in the application.

Claims 1-12, 14-43, 45-61 and 63-65 have been rejected.

Claims 1-12, 14-43, 45-61 and 63-65 are objected to.

Claims 1, 2, 3, 32, 61, 63 and 64 have been amended, as set forth herein, solely to correct informalities noted by the Examiner, and not for any reason related to patentability.

I. **REQUEST TO WITHDRAW FINALITY OF PENDING OFFICE ACTION**

Applicant respectfully requests the Office withdraw the finality of the outstanding office action. The final Office Action raises, for the first time, new objections to certain claim language that has been pending either prior to, or since the filing of, the request for continued examination (RCE).

With respect to Claims 1, 32, 61, 63, at the time of filing the RCE, certain claims were amended to recite "operable to." The prior Office Action (June 30, 2006) did not object to this specific claim language, and therefore, the outstanding office action raises this issue for the first time. Nonetheless, Applicant has amended these claims.

With respect to Claims 34, 35, 42, 52, 53-55, 57 and 65, the claim language objected to was already present in the claims prior to filing of the RCE. The prior Office Action (June 30, 2006) did not object to this specific claim language, and therefore, the outstanding office action raises this issue for the first time. Applicant has not amended these claims, and Applicant respectfully submits that

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the limitation "adapted to" properly refers to structure or mechanism that provides the stated function.

Therefore, the finality of the outstanding office action is improper, as the Applicant has not been given adequate notice and a reasonable opportunity to respond to these new claim objections.

II. REJECTIONS UNDER 35 U.S.C. § 103

Claims 1-10, 14-17, 19-41, 45-46, 48-61 and 63-65 were newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheung (US Patent No. 6,515,964) in view of Key (US 6,084,955). Claims 11-12, 42-43 and 66 were newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheung (US Patent No. 6,515,964) and Key (US 6,084,955) and further in view of Lo (US 6,798,786). Claims 18 and 47 were newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheung (US Patent No. 6,515,964) and Key (US 6,084,955) and further in view of Vargo (US 6,356,545). The rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

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Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

Independent Claims 1, 32, 61 and 63 recite method, apparatus and article in which a throughput measurement request is transmitted that causes a trace to propagate via a path between the origination terminal and the destination terminal, and in response to the trace, information is received identifying one or more network resources on the path.

Cheung's gateways do accumulate network performance parameters (Cheung, Col. 5, lines 65 thru Col 6, lines 4; Col. 7, lines 34-39; Col 8, lines 42-50), however, this description does not

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disclose (or even appear to be materially relevant to) either (1) transmitting a throughput measurement request . . . causing a trace to propagate via a path between the origination and destination terminals, or (2) in response to the trace, receiving information identifying a network resource(s) on the path. In fact, Cheung appears to monitor global or overall parameters of a network (current and projected "traffic," call delay, packet loss, error rate) upon which to base the call admission decision. Cheung, Col. 7, lines 14-33; Col 8, lines 42-50. Thus, in Cheung, which path the data packets will traverse between the source and destination (in the packet network) appear to be irrelevant – only the overall network operating characteristics seem important. In contrast, Applicant additionally teaches that it is important to identify which network resources (e.g., gateways, routers, paths, links, terminals, etc.) will be utilized in the path(s) between the origination terminal and destination terminal. With this information, the Applicant is able to make the call admission decision for the anticipated path (or paths) of the call.

The Office Action argues that because Keys generally describes measuring the load between two nodes, it necessarily follows that Keys discloses that "a packet must traverse the path for determining the utilized capacity" citing Keys Col. 3, line 61 through Col. 4, line 10. See, Office Action, page 4. Such conclusion, or more appropriately, such "assumption," is not supported by the Keys disclosure. Keys fail to identify how the "load" is measured. There is no description or indication that (1) Keys' measured "load" is determined in response to a throughput measurement request causing a trace to be propagated between the origination and destination terminals, or (2) Keys' network manager receives, in response to the trace, information identifying a network

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resource(s) in the path between the origination and destination terminals. Thus, the asserted teachings of Keys, as well as the proposed combination with Keys, is not well-taken.

In sum, upon a detailed review of Cheung and Keys, each reference fails to disclose or describe at least two elements (as identified above) of independent Claim 1 (and independent Claims 32, 61 and 63, as well as the dependent Claims), and neither of the references, taken alone or in combination, teach or suggest the Applicant's claimed invention.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 103(a) rejections of Claims 1-10, 14-17, 19-41, 45-46, 48-61 and 63-65.¹

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

¹ With respect to the rejections of dependent Claims 11-12, 18, 42-43, 47 and 66, none of the secondary references cure or include the noted deficiencies in the Cheung and Keys references.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@munckbutrus.com.

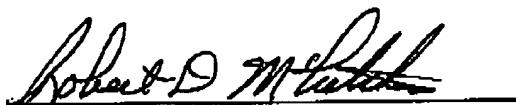
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Munck Butrus Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK BUTRUS, P.C.

Date:

12/12/2006



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